



PATENT
Attorney Docket No. 23758

#3
9/18/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Gregory S. HAMILTON

Examiner: L. Stockton

Serial No.: 09/741,437

Art Unit: 1626

Filed: December 21, 2000

For: **HYDANTOIN DERIVATIVES, PHARMACEUTICAL COMPOSITIONS,
AND METHODS OF USING SAME**

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Official Action dated July 26, 2001, due for reply by August 26, 2001. Accordingly, this response is filed within the time period allowed for response by the Examiner.

SUMMARY OF RESTRICTION REQUIREMENT

The Examiner has required restriction of claims 1-62 under 35 U.S.C. 121 to a single invention encompassed by the claims as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to products, classified in class 548, subclass 453.
- II. Claims 6-15, drawn to a method, classified in class 514, various subclasses.
- III. Claims 16-19, drawn to methods, classified in class

- 514, various subclasses.
- IV. Claims 20-23, drawn to a method, classified in class 514, various subclasses.
 - V. Claims 24-31, drawn to a method, classified in class 514, various subclasses.
 - VI. Claims 32-36, drawn to products, classified in class 546, subclass 113+.
 - VII. Claims 37-46, drawn to a method, classified in class 514, various subclasses.
 - VIII. Claims 47-50, drawn to a method, classified in class 514, various subclasses.
 - IX. Claims 51-54, drawn to a method, classified in class 514, various subclasses.
 - X. Claims 55-62, drawn to a method, classified in class 514, various subclasses.

The inventions are distinct, each from the other because of the following reasons: the products of Group I and Group VI differ materially in structure and element so much so as to be patentably distinct. In addition, a reference which anticipates one group may not even render obvious the other. Additionally, the products of Group I can be used in materially different processes of using such as the method of Group II or the method of Group III, etc.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the search required for Group I, for example, is not required for Group VI, restriction for examination purposes as indicated is proper.

Additionally, an election of a single disclosed species {ie., Example number, page number and structural depiction} is required from whichever group is elected. Moreover, whatever specific compound is ultimately elected, applicants are required to list all claims readable thereon.

Applicants is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

As the basis for requiring this restriction/election, the

Examiner has only provided that the inventions falling under the above claims are patentably distinct.

ELECTION

→ Applicants provisionally elect Group I, claims 1-5, with traverse. Additionally, Applicants provisionally elect compound 3 as found on page 45, lines 32-33 as the single species, namely (7aS)-2-(4-(Trifluoromethyl)phenyl)perhydropyrrolo[1,2-c]imidazole-1,3-dione. This compound is readable on claims 1-31.

TRAVERSAL

Applicants respectfully traverse the Examiner's restriction requirement for the following reasons.

Applicants respectfully request the Examiner to recombine Groups I, II, III, IV, and V. The restriction requirement is improper since the reasons which have been offered by the Examiner do not appear to apply with respect to these Groups. Under MPEP 808.02, restriction is only proper if: (1) each distinct subject has attained recognition in the art as a separate subject by separate classification; (2) each distinct subject has attained recognition in the art as a separate subject even though classified

together; or (3) the separate subject matter would require a different field of search. In the present application, an examination of all of claims 1-31 would not pose a serious burden because a search of any one of the groups would require searching the art areas appropriate to the other. All of Groups II, III, IV, and V are directed to methods of using the same novel compounds as those included within Group I. It would require no additional searching on the part of the Examiner to search all of Groups II, III, IV, and V in addition to Group I.

Regarding restriction between product and process of use claims, the Examiner is reminded that if "applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined". MPEP §821.04. Accordingly, if the Examiner a) refuses to recombine Groups II-V with Group I and b) subsequently allows Group I, applicants hereby reserve the right to rejoin the withdrawn Groups II-V to allowed Group I.

Moreover, these classes and subclasses are all assigned to the Examiner's art unit. Given their overlapping subject matter and identical classifications, examinations of all the invention Groups would not pose a serious burden because they would be coextensive.

Finally, applicants have paid a filing fee for an examination

of all the claims in this application. If the Examiner refuses to examine the claims paid for when this application was filed, applicants must pay duplicative fees to file divisional applications for the non-elected or withdrawn groups of claims.

Accordingly, applicants urge the Examiner to re-combine Groups I, II, III, IV, and V for the reasons stated above.

CONCLUSION

In view of the foregoing, applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement and to examine claims 1-31 pending in this application.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

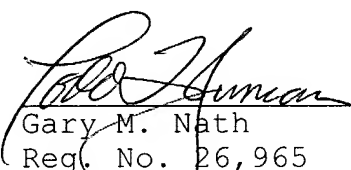
NATH & ASSOCIATES PLLC

Date:

Aug. 22, 2001

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TRANSMITTAL LETTER

Commissioner for Patents
Washington, D.C. 20231

Sir:

Submitted herewith for filing in the U.S. Patent and Trademark
Office are the following:

- 1) Transmittal Letter; and
- 2) Response to Restriction Requirement.

The Commissioner is hereby authorized to charge any fee
deficiency or credit any overpayment to our Deposit Account
No. 14-0112.

Respectfully submitted,

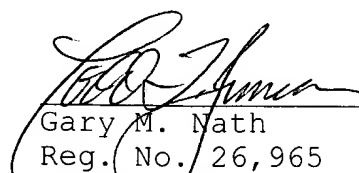
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